



08-13-04

IFW

DAC

[10537/181]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Anita MARTEN
Serial No.: 09/991,022
Filing Date: November 21, 2001
For: INITIAL SOLIDS MIXTURE FOR
A LATER ORGANIC COATING
APPLICATION

Group Art Unit: 1755
Examiner: Shalie A. Manlove
Confirmation No.: 2956

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER
37 C.F.R. § 1.181 AND, ALTERNATIVELY, PETITION TO
REVIVE UNDER 37 C.F.R. § 1.137(b)**

S I R:

The above-identified application was held abandoned on July 1, 2004 for alleged failure to file a proper Request for Continued Examination ("RCE"). Applicant hereby petitions under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment on the basis that the RCE filed on April 9, 2004 was proper. In the alternative, Applicant hereby petitions under 37 C.F.R. § 1.137(b) to revive the present application.

Applicant filed an RCE on April 9, 2004 in response to the Final Office Action dated October 10, 2003. The RCE was accompanied by an Amendment ("the Amendment") and a petition for a three-month extension of time, extending the period of response from January 10, 2004 to April 12, 2004 (April 10, 2004 and April 11, 2004 being a Saturday and Sunday, respectively). The RCE authorized charging of the fee under 37 C.F.R. § 1.17(e) to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600. The RCE also authorized charging of the extension fee under 37 C.F.R. § 1.136(a) to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600. The RCE further authorized

NY01 714105

Express Mail Label No. EV 323023303 US

08/16/2004 HAL111 00000007 110600 09991022
01 FC:1453 1330.00 DA

charging of any additional fees to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600.

A Notice of Abandonment was mailed on July 1, 2004. The Notice of Abandonment includes a "Notice of Improper Request for Continued Examination (RCE)," which alleges that "[t]he request was not accompanied by a submission as required by 37 CFR 1.114." As indicated above, however, the Amendment was submitted with the RCE. Indeed, page 2 of the Notice of Abandonment apparently recognizes that the Amendment was submitted with the RCE by alleging that "claims that are independent and distinct from the claims previously claimed" were presented. Accordingly, it is respectfully submitted that the RCE was proper and that the holding of abandonment should be withdrawn.

The only conditions necessary for filing an RCE are: (1) that prosecution is closed; (2) that applicants file a "submission"; and (3) that applicants pay the fee set forth in 37 C.F.R. § 1.17(e). Since the Office Action dated October 10, 2003 was final, prosecution was closed at the time the RCE was filed. The RCE was filed prior to the times set forth in 37 C.F.R. § 1.114(a)(1), (2) and (3). As indicated above, the RCE authorized charging of the fee under 37 C.F.R. § 1.17(e) to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600. Furthermore, the Amendment accompanied the RCE. It is therefore respectfully submitted that the requirements of 37 C.F.R. § 1.114 were fully satisfied. Accordingly, it is respectfully submitted that the RCE was proper and that the holding of abandonment should be withdrawn.

For an amendment to satisfy the submission requirement of 37 C.F.R. § 1.114, the Amendment must merely satisfy the requirements of 37 C.F.R. § 1.111. 37 C.F.R. § 1.114(c). It is respectfully submitted that the Amendment submitted with the RCE fully satisfied the requirements of 37 C.F.R. § 1.111. Applicant respectfully submits that the Amendment was a *bona fide* attempt to advance the application to final action. Consistent with 37 C.F.R. § 1.111, the Amendment was in writing and distinctly and specifically pointed out the supposed errors in the Examiner's action and replied to every ground of objection and rejection in the Final Office Action dated October 10, 2003. Specifically, page four of the Amendment responded to the Examiner's assertion that Applicant withdrew "the coating composition by original presentation," as alleged in the Advisory Action of January 14, 2004, pages four to six of the Amendment responded to the rejection of claims 1, 2, 24 and 26 under 35 U.S.C. § 112, first paragraph, and pages 6 to 7 of the Amendment responded to the rejection of claims 1 to 7, 9, 10 and 24 to 26 under 35 U.S.C. § 112, second paragraph. In

view of the foregoing, it is respectfully submitted that the Amendment fully complied with the requirements of 37 C.F.R. § 1.111. It is therefore respectfully submitted that the RCE was proper and that the holding of abandonment should be withdrawn.

On page 2 of the Notice of Abandonment, it is stated that “[o]ne cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions) (see 37 CFR 1.145) because 35 U.S.C. 132(b) and 37 CFR 1.114 provide continued examination of an application and not examination of a continuing examination.” It is noted that 37 C.F.R. § 1.145 provides that “[i]f, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144” (emphasis added). By holding the present application abandoned on the basis that the Amendment allegedly presents “claims that are independent and distinct from the claims previously claimed,” Applicant has been refused its right to request reconsideration under 37 C.F.R. § 1.143 and its right to petition the Director for review under 37 C.F.R. § 1.144. It is therefore respectfully submitted that the holding of abandonment was improper and in direct contravention to 37 C.F.R. §§ 143 to 145.

Moreover, it is respectfully submitted that the “Notice of Improper Request for Continued Examination (RCE)” Form PTO-2051 does not even contemplate that a submission that presents “claims that are independent and distinct from the claims previously claimed” is a reason for considering an RCE to be improper. While it is respectfully submitted that the RCE was proper and fully compliant with the requirements of 37 C.F.R. § 1.114, it is respectfully submitted that even if the Amendment submitted with the RCE presented “claims that are independent and distinct from the claims previously claimed” -- which is not conceded -- the holding of abandonment was nevertheless improper. In this regard, Applicant refers to M.P.E.P. § 706.07(h)(VI), which states that “[i]f reply to a final Office action is outstanding and the submission is not fully responsive to the final Office action, then it must be a *bona fide* attempt to provide a complete reply to the final Office action in order for the RCE to toll the period for reply.” Section 706.07(h)(VI) further states that one “[s]ituation[] where a submission is not a fully responsive submission, but is a *bona fide* attempt to provide a complete reply” is “[p]resentation of claims for [a] different invention.” In this regard, M.P.E.P. § 706.07(h)(VI) states that “[i]f an RCE is filed with an

amendment canceling all claims drawn to the elected invention and presenting only claims drawn to a nonelected invention, the RCE should be treated as proper but the amendment should not be entered and that “[t]he amendment is not fully responsive and applicant should be given a time period of one month or thirty days (whichever is longer) to submit a complete reply” (emphasis added). This practice is consistent with 37 C.F.R. §§ 1.135(c) and 1.145 and with the procedure outlined in M.P.E.P. § 821.03, which section is referred to by M.P.E.P. § 706.07(h)(VI). Accordingly, even if the Amendment submitted with the RCE is considered to present “claims that are independent and distinct from the claims previously claimed” -- which is not conceded -- it would have been proper for the Office to provide Applicant with an opportunity to submit a complete reply, to seek reconsideration under 37 C.F.R. § 1.143 and/or to petition to the Director under 37 C.F.R. § 1.144 rather than to hold the present application abandoned. Accordingly, it is respectfully submitted that holding the present application abandoned was improper and in direct contravention to the procedures specifically outlined in M.P.E.P. §§ 706.07(h)(VI) and 821.03.

In view of all of the foregoing, it is respectfully submitted that the RCE filed on April 10, 2004 fully complied with the requirements of 37 C.F.R. § 1.114 and that the holding of abandonment was improper. Applicant therefore respectfully petitions under 37 C.F.R. § 1.181(a) for withdrawal of the holding of abandonment. No fee is believed to be required in connection with this petition under 37 C.F.R. § 1.181(a). However, the Commissioner is authorized to charge any fees that may be necessary in connection with this petition under 37 C.F.R. § 1.181(a) to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600.

In the alternative, if the petition under 37 C.F.R. § 1.181(a) for withdrawal of the holding of abandonment is not granted, Applicant hereby petitions under 37 C.F.R. § 1.137(b) to revive the above-identified application. Enclosed herewith is a continuation application under 37 C.F.R. § 1.53(b) as the reply to the Final Office Action dated October 10, 2003 as required under 37 C.F.R. § 1.137(b)(1). It is believed and respectfully submitted that a continuation application under 37 C.F.R. § 1.53(b) constitutes a proper reply as required by 37 C.F.R. § 1.137(b)(1). See M.P.E.P. § 711.03(c)(II)(A)(2)(b). As regards the petition fee under 37 C.F.R. § 1.17(m) as required under 37 C.F.R. § 1.137(b)(2), the Commissioner is authorized to charge the fee under 37 C.F.R. § 1.17(m) to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600. The Commissioner is also authorized to charge any other fees that may be necessary in connection with this alternative


petition under 37 C.F.R. § 1.137(b) to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600. As required by 37 C.F.R. § 1.137(b)(3), the entire delay between the filing of the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. Accordingly, if the petition under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment is not granted, Applicant hereby petitions under 37 C.F.R. § 1.137(b) for revival of the present application.

The Commissioner is authorized to charge any fees that may be required in connection with this communication to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600. A duplicate copy of this communication is enclosed for charging purposes.

Respectfully submitted,

KENYON & KENYON

Dated: August 12, 2004 By:


Richard L. Mayer
Reg. No. 22,490
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646

*Chili
B.no.
42,194*